

P30879.A01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jan BATZER et al.

Confirmation No. 6148

Group Art Unit: 1617

Serial No. : 10/824,102

Examiner: Huynh, Carlic K

Filed : April 13, 2004

For : COSMETIC OR DERMATOLOGICAL ACTIVE INGREDIENT COMBINATION

ELECTION WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is in response to the requirement for restriction under 35 U.S.C. § 121 mailed from the U.S. Patent and Trademark Office on August 13, 2007. Inasmuch as the one-month shortened statutory period for reply is set in the Office Action to expire on September 13, 2007, this response is being filed by the initial due date for response. However, if any extension of time is necessary, this is an express request for any necessary extension of time and authorization to charge any required extension of time fee or any other fees which may be required to preserve the pendency of the present application to Deposit Account No. 19-0089.

RESTRICTION REQUIREMENT

The Examiner has required restriction under 35 U.S.C. 121 to one of the following inventions:

- I Claims 1-45, drawn to a cosmetic or dermatological preparation comprising an anti-oxidant and 8-hexadecene-1,16-dicarboxylic acid, classified in class 424, subclass 401.

- II Claims 46-55, drawn to a method of treating unwanted pigmentation of the skin or pigmentation disorders comprising administering a cosmetic or dermatological preparation comprising an anti-oxidant and 8-hexadecene-1, 16-dicarboxylic acid, classified in class 424, subclass 401.

Furthermore, the Examiner requests that an Election of Species directed to the following patentably distinct species be made:

- (1) A single disclosed species of an antioxidant.

ELECTION

In order to be responsive to the requirement for restriction, Applicants elect, with traverse, the invention set forth in **claims 1-45** (the invention of **Group I** as identified in the Restriction Requirement) and **folic acid** as species of an antioxidant. Currently at least claims 1 and 5-11 read on the elected species

TRAVERSE

Applicants respectfully submit that a restriction requirement is inappropriate in this case. Even if one were to assume, *arguendo*, that the inventions of Groups I to II are distinct, the requirement for restriction should be withdrawn because there is no serious burden.

In MPEP Chapter 800, the Office sets forth its policy by which examiners are guided in requiring restriction under 35 U.S.C. § 121. Section 803 states that “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants note that the inventions of Groups I to II identified in the Restriction Requirement relate to a cosmetic or dermatological preparation comprising an anti-oxidant and 8-hexadecene-1, 16-dicarboxylic acid and to a method a method of treating unwanted pigmentation of the skin or pigmentation disorders which comprises administering this cosmetic or dermatological preparation. Accordingly, as a practical matter, the searches for inventions I and II should significantly overlap. For example, a search for the invention of Group I should cover many of the areas that are also relevant for the invention of Group II. Thus, the search burden would not be serious. Incidentally, the inventions of Groups I and II are classified in the same class, i.e., class 424, subclass 401, which is another indication that the search and examination burden would not be serious.

Furthermore, the election of species requirement also is inappropriate. In this regard, Applicants note that all of the claimed compositions comprise 8-hexadecene-1,16-dicarboxylic acid. Accordingly, if a search for documents which disclose preparations which comprise 8-hexadecene-1,16-dicarboxylic acid is carried out, this search will necessarily uncover all documents

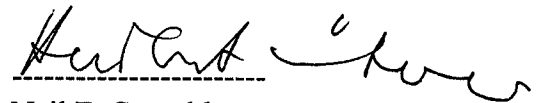
P30879.A01

which disclose preparations that comprise 8-hexadecene-1,16-dicarboxylic acid in combination with any other compounds, including all preparations which comprise 8-hexadecene-1,16-dicarboxylic acid and any anti-oxidant. Accordingly, the search burden would not be significantly different from a search for documents which disclose preparations that comprise 8-hexadecene-1,16-dicarboxylic acid in combination with folic acid.

For the above reasons alone, the Restriction Requirement and the Election of Species Requirement should be withdrawn, which action is respectfully requested.

Should there be any questions, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,
Jan BATZER et al.



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